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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,021	09/05/2003	Makarand P. Gore	200312226-1	8140

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HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER	
LE, HOA VAN	

ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/656,021	GORE, MAKARAND P.	
	Examiner	Art Unit	
	Hoa V. Le	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 October 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) *6-16* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 17-19 with respect to the applied species* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-19* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ---.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

This is in response to Paper filed on 15 October 2004.

I. Applicant elects the invention of Group I, claims 1-5 being acknowledged. Applicant urges that the invention of claims 17-19 is so related to those in claim 2. It is reasonable. Therefore, the related claims 17-19 as urged will be allowed to be rejoined with claim 2 when it is considered, searched, examined and found to be allowable.

II. Applicant elects the species on the record have been considered and searched. The consideration and search are extension to the applied species. Others have not been considered, searched or examined until all of the elected and applied species are overcome.

III. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-2, 4-5, (17-19 for the record) with respect to the elected and urged claimed inventions are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7, 12, 36-42 and 47 of copending Application No. 10/351,188. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The embodiments of the applied claims are the same and are read as those in the instant claims , except for the narrow "...phthalocyanine chromophore" embodiment in the instant claim. (1) However, the broadly claimed embodiments with respect to "phthalocyanine" and "naphthalocyanine" in the applied claims 5 and 40 are broad enough to read on and are covered those narrower "...chromophore" in the instant claims. (2) Accordingly, it is reasonable that the broad "phthalocyanine" and "naphthalocyanine" embodiments in the applied claims 5 and 40 would have and include "chromophore" in the instant claims.

IV. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 3 with respect to the elected and urged claimed inventions is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 12, 36-40 and 47 of copending Application No. 10/351,188. Although the

conflicting claims are not identical, they are not patentably distinct from each other because the specific and narrow ...phthalocyanine containing compounds in the instant claim is are read within those in the applied claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

V. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3-5) with respect to the applied species are rejected under 35 U.S.C. 102(b) as being anticipated by Tai et al (5,484,685).

Tai et al disclose, teach, demonstrate and reduce to practice with a composition comprising a matrix having a silicon containing phthalocyanine chromophore being dissolved thought out and in it. The composition is capable of absorbing a laser radiation having a wavelength of about (830 nm. It is known in the art in the infrared or IR region). Please see col.5:66 to 6:54, at least Compound 12 at cols.13 and 14, SYNTHESIS EXAMPLE 12at col.42:43 to 43:22 and EXAMPLE 19 at col.58:28-35. Since Tai et al disclose, teach, demonstrate and reduce to practice with the claimed embodiments, they are found to be anticipated by Tai et al.

VI. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 3-5 with respect to the applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Tai et al (5,484,685).

Tai et al suggest a composition comprising a matrix having a silicon containing phthalocyanine chromophore being dissolved thought out and in it. The composition is capable of absorbing a laser radiation having a wavelength of about (830 nm. It is known in the art in the infrared or IR region). Please see col.5:66 to 6:54, at least Compound 12 at cols.13 and 14, SYNTHESIS EXAMPLE 12at col.42:43 to 43:22 and EXAMPLE 19 at col.58:28-35. Since Tai et al suggest the claimed embodiments, they are found to be rendered prima facie obvious by Tai et al.

VII. Takeuchi et al (JP 5-278329(Abstract)), Satake et al (5,243,797 and 5,434,119) are cited to show the state of the art.

VIII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
11 January 2005

HOA VAN LE
PRIMARY EXAMINER